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In re Application of	:	
BRANCACCIO	:	Decision on Petition
Serial No.: 10/538,736	:	
Filed : 11 August 2005	:	
Attorney Docket No.: 4636-25	:	

This letter is in response to the Petition under 37 C.F.R. 1.144 and 1.181 filed on 28 June 2007 requesting review of a lack of unity determination. The delay in acting upon this petition is regretted.

**BACKGROUND**

This application was filed as a national stage application under 35 USC 371 of PCT/IT02/00807 and as such, is eligible for unity of invention practice.

On 11 January 2006, the examiner divided claims 1-37 into thirteen groups and reasoned that unity was lacking among these groups.

On 10 March 2006, Applicants elected Group I with traverse.

On 3 May 2006, the examiner considered the traversal and found it persuasive in part. Groups I, IV and II were rejoined and claims 1-25 were examined together on the merits. Claims 26-39 were not treated on the merits.

Claims 1-25 were rejected under 35 USC 112, 1<sup>st</sup>, for scope of enablement.  
Claims 18, 19 and 23 were rejected under 35 USC 101, and 35 USC 112, 2<sup>nd</sup> for being indefinite "use" claims.

On 27 July 2006, applicants cancelled claims 26-39, directed to the non-elected inventions and added new claims 40-42.

On 23 October 2006, the application was transferred to a second examiner and a second lack of unity determination was prepared. The claims 1-25 which had already been examined together were divided into six groups and further subject to species election requirements.

On 18 December 2006, Applicants elected Group II with traverse and also elected various species, as required.

On 27 March 2007, the examiner considered the lack of unity requirement and made it final. Claims 1-9, 11-18, 24-25 and 40-42 were rejected. Claims 10 and 19-23, which had been rejected in the first action on the merits, were withdrawn from consideration.

On 27 June 2007, applicants filed a response to the Office action. On 28 June 2007, applicants filed this petition.

### **DISCUSSION**

The file history and Applicants' petition filed 28 June 2007 have been considered carefully. Per 35 USC 121, restriction is discretionary, not mandatory. The first examiner was within their rights to examine together inventions which another examiner may wish to divide apart. The issue as to whether the second lack of unity determination was made correctly is of secondary concern here. The issue that needs to be addressed in this decision: the second unity of invention determination no longer permits applicants to resolve rejections made on claims which had been examined and now are withdrawn from examination.

The second lack of unity determination resulting in the withdrawal of claims 10, 19-23 following rejections made by the Office has denied applicant the opportunity to resolve the rejections of record made on claims 10 and 19-23 during the prosecution of this application. For this reason, the second lack of unity determination is withdrawn.

### **DECISION**

Accordingly, the petition filed under 37 CFR 1.144 and 1.181 on 28 June 2007 is **GRANTED**. The lack of unity determination set forth on 13 July 2006 has been withdrawn.

The application will be forwarded to the examiner to consider the papers filed 27 June 2007 and to prepare an Office action consistent with this petition decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-272-8300.



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